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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,446	01/02/2002	Lee E. Cannon	29757/AG75/US	4837

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EXAMINER

COBURN, CORBETT B

ART UNIT PAPER NUMBER

3714

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,446

Applicant(s)

CANNON, LEE E.

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 44-55 is/are pending in the application.
- 4a) Of the above claim(s) 18-23 and 44-55 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 and 17 is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/2/02, 10/3/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 & 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webb et al. (US Patent Number 6,461,241) in view of Weiss (US Patent Number 6,309,299).

Claim 1: Webb teaches a gaming system, comprising: a primary game (slot machine game) and a secondary game of mental strategy (grid alignment games, tic-tac-toe, chess, checkers, Col 2, 1-13), in which a gamer takes a plurality of turns, each turn of said secondary game being awarded upon the occurrence of at least one of a predetermined event in said primary game and a particular result during play of said primary game. (Col 2, 21-40) Webb teaches players competing with the slot machine (Col 2, 5-12), but fails to teach networked secondary games in which two or more gamers compete. Weiss teaches competition between two or more players on networked secondary games. Competition between players is known to increase the popularity of games. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Webb in view of Weiss to include competition between two or more players on networked secondary games in order to increase the popularity of the game.

Claim 2: Webb's secondary game comprises a matrix (or grid) type game. (Col 2, 23-25)

3. Claims 3-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webb & Weiss as applied to claim 2 in view of Pente.

Overall discussion: Webb & Weiss teach the invention substantially as claimed but does not teach that the bonus game is Pente. Webb suggests that the bonus game may be a grid game that requires a player to align a predetermined number of markers on a grid pattern. This is the basic premise of the game of Pente. Furthermore, Webb teaches that the bonus game may be a strategy game such as tic-tac-toe, checkers, or chess. But Webb does not actually describe the rules of the alignment game. As pointed out above, it is well known in the art to look to other popular games for implementation as a bonus game. These games are known to add interest to the game and thus to attract players. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Webb to implement Pente as a bonus game in order to add interest to the game and thus to attract players.

Claims 3-8, 13 & 14: Pente is matrix type game, upon positioning at least two first game pieces along a line including at least one second game piece, the gamer captures at least said at least one second game piece. Upon said positioning, the gamer may also capture said at least two first game pieces. At least one second game piece is captured when said at least two first game pieces are positioned adjacent to and at opposite ends of a single second game piece or a sequence of linearly arranged second game pieces. At least one second game piece is captured when at least three first game pieces are positioned in-line with said at least one second game piece. Upon being captured, said at least one second game piece is removed from said matrix. Upon being captured, said at least one second

game piece becomes a first game piece (i.e., it can be captured by the other player). By skillful positioning said at least two first game pieces, the gamer may prevent capturing of said at least one-second game piece. By skillful positioning at least one additional first game piece along said line, the gamer may recapture at least each second game piece located along said line. See Pente Rules for overview of the game.

Claims 9, 10: Webb teaches a fixed payout whenever a player places a marker on the grid. (Col 2, 40-42) This is equivalent to providing an award whenever the gamer captures a piece.

Claim 11: While Webb does not disclose the amount of the payout, setting the award value is fundamental to maintaining profitability. No one of ordinary skill in the art could remain in business long if they did not know how to choose a payout level to maintain profitability. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Webb to have the award associated with each game piece be an amount that has been wagered on that game piece in order to maintain the desired level of profitability.

Claim 12: While Webb does not disclose the amount of the payout, setting the award value is fundamental to maintaining profitability. No one of ordinary skill in the art could remain in business long if they did not know how to choose a payout level to maintain profitability. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Webb to have the award associated with each game piece be based on a result in said primary game that resulted in placement of that game piece in order to maintain the desired level of profitability.

Claim 15: While Webb does not disclose the amount of the payout, setting the award value is fundamental to maintaining profitability. No one of ordinary skill in the art could remain in business long if they did not know how to choose a payout level to maintain profitability. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Webb to have provided the gamer with an award for each captured game piece and an additional award for previously preventing capture of said at least one second game piece upon recapturing at least each second game piece located along said line in order to maintain the desired level of profitability.

Allowable Subject Matter

4. Claims 16 & 17 are allowed.

Response to Arguments

5. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl J. Tyler can be reached on (571) 272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Corbett B. Coburn
Examiner
Art Unit 3714